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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/561,368 | 12/20/2005 | Hiroaki Koshima | 281974US0PCT | 9727 |
| 22850 | 7590 | 12/30/2009 | | |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | | |
| EXAMINER | | | | |
| GOLOBOW, JAMES C | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1797 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 12/30/2009 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

Office Action Summary

Application No.

10/561,368

Applicant(s)

KOSHIMA ET AL.

Examiner

James Goloboy

Art Unit

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/8/09.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6, 8 and 10-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 8, 10-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

1. Applicant's amendment filed 9/8/09 overcomes the rejections over Goodwine and Tipton in the office action mailed 6/8/09, but fails to overcome the rejections over Meyer alone or Meyer in view of Tiffany. New grounds of rejection for claims 10-11, necessitated by the amendment, are also set forth below.

Claim Rejections - 35 USC § 103

2. Claims 1-3, 6, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer.

This rejection is adequately set forth in paragraph 2 of the office action mailed 6/8/09, which is incorporated here by reference.

3. Claims 1-3, 6, 8, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tiffany in view of Meyer.

This rejection is adequately set forth in paragraph 5 of the office action mailed 6/8/09, which is incorporated here by reference.

4. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer in view of Harrison (U.S. PG Pub. No. 2004/0102338).

The discussions of Meyer in the paragraphs above and previous office actions are incorporated here by reference. Meyer discloses a lubricating additive meeting the limitations of claim 1 but does not disclose its incorporation into a transmission fluid.

Harrison, in the abstract, discloses a low molecular weight branched alkenyl succinimide, where the alkenyl group comprises 8 to 32 carbon atoms, similar to that of Meyer. In paragraphs 111-117 Harrison discloses the amines used to prepare the succinimide, including substituted piperazines (paragraph 115). In paragraph 186 Harrison teaches that the additive is useful in automatic or continuously variable transmission fluids, as recited in claims 10-11. The use of the succinimides of Meyer as the succinic acid derivatives in the transmission fluids of Harrison meets the limitations of claims 10-11.

It would have been obvious to one of ordinary skill in the art to use the succinimides of Meyer in the transmission fluid compositions of Harrison, as Harrison teaches that low molecular weight succinimides containing a ring structure are useful in such compositions.

Response to Arguments

5. Applicant's arguments filed 9/8/09 have been fully considered but they are not persuasive. Applicant argues that Tiffany and Meyer do not disclose a lubricating composition for driving systems. However, the amended claims do not recite such a lubricant. Rather, they recite a lubricant additive for use in driving systems. Since Meyer discloses the claimed additive, it must also be suitable for use in driving systems, meeting the limitations of the amended claim.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/
Acting SPE of Art Unit 1797